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Hirokazu Mihashi

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EXAMINER

BOMBERG, KENNETH

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3754

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,916	<b>Applicant(s)</b> MIHASHI ET AL.	
	<b>Examiner</b> KENNETH BOMBERG	<b>Art Unit</b> 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/9/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

2. The use of the trademark MILLIPORE EXPRESS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Drawings***

3. Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 1-2, “the internal layer bag” lacks antecedent basis in claim 1.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application No. 2002/0153386 to Uetake et al. (Uetake).

Uetake teaches:

**In Reference to Claim 1**

A container with a filter (1) comprising:

a bottle (2) having a mouth portion (2a);

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a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle; and

a filter (7, 50) provided in the discharging pass;

wherein said filter (7,50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging and an internal liquid holding member (50) which is made of porous substance (perforations 50) and placed upstream side of the filtration film; and

a surface of said internal liquid holding member is in contact with a surface of the filtration film. (see Fig. 1 and [0046]).

In Reference to Claims 4 and 7

See Fig. 1 and [0046].

In Reference to Claim 5

See Fig. 1 and [0038] – [0041].

8. Claims 1, 4, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi).

Shiraishi teaches:

In Reference to Claim 1

A container with a filter (1) comprising:

a bottle (2) having a mouth portion (2a);

a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle; and

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a filter (7, 50) provided in the discharging pass;

wherein said filter (7,50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging and an internal liquid holding member (50) which is made of porous substance (perforations 50a) and placed upstream side of the filtration film; and

a surface of said internal liquid holding member is in contact with a surface of the filtration film. (see Fig. 3 and [0067]).

In Reference to Claims 4 and 7

See Fig. 3 and [0067].

In Reference to Claim 5

See Figs. 1, 3 and [0056] – [0060].

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uetake in view of Applicants Admitted Prior Art (AAPA).

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In Reference to Claim 2

Uetake teaches a container with filter substantially according to claim 1, but does not teach the particular filter according to the claim. AAPA (specification page 11, line 15 – page 12, line 6) teaches that the claimed filter is a “Millipore Express Plus membrane filter” i.e. commercially available prior art filter.

It would have been obvious to one having ordinary skill in the art to have selected the AAPA Millipore Express Plus membrane filter for use in the device of Uetake since Uetake suggests the use of any filter suited for preventing bacteria from entering the upstream side from the downstream side (see [0034]). Further the application of the AAPA filter to Uetake constitutes no more than combining prior art elements according to known methods to yield predictable results and the simple substitution of one known element for another to obtain predictable results supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385.

In Reference to Claim 3

When AAPA prior art filter is used with Uetake, (with the same liquid) the device would inherently perform in the same manner. Further, “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” (see MPEP 2144.05 II)

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11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi) in view of US Patent 5,497,910 to Meadows et al (Meadows).

In Reference to Claim 6

Shiraishi teaches:

A container with a filter (1) as set forth in claim 1 (see rejection of claim 1 above):

Shiraishi further teaches:

wherein a dispensing valve (8) has memory which expands said dispensing valve and generates negative pressure in the container so that a pressure difference between the negative pressure and an ambient pressure becomes higher than the filtration resistance thus liquid left downstream side of the filtration film is aspirated to up stream side of the filtration film (see [0043] and [0053]).

Shiraishi differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into an up stream side of the of the filter rather than the memory of internal layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]).

Meadows teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57-62; col. 5, lines 35-43).



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It would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows in the dispenser of Shiraishi because doing so would allow the suck back function to be performed without the use of a resilient valve.

Further the application of the teaching of Meadows to Shiraishi constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining references listed on the attached PTO-892 have been included because they show hand held dispensing devices with inner and outer compressible containers.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH BOMBERG whose telephone number is (571)272-4922. The examiner can normally be reached on Monday-Thursday and alternative Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Kenneth Bomberg/  
Primary Examiner, Art Unit 3754